

First named inventor: Holt  
Serial no. 09/682,316  
Filed 8/19/2001  
Attorney docket no. 1044.003US1

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### REMARKS

#### Claim rejections under 35 USC 101

Claims 1-3 have been rejected under 35 USC 101 because the claimed invention has been indicated as being directed to non-statutory subject matter. In particular, the Examiner states that the method only requires a trivial use of technology "and can be accomplished without a computer-aided device."

Applicant has amended claim 1, from which claims 2-3 depend, such that the user makes an order "in a computerized manner." Support for this amendment is found in the patent application as filed in paragraph [0012], in which it is stated that "[t]he user may place the order online on a web site, [or] by email . . . ." Thus, the invention can no longer be accomplished without a computer-aided device, and therefore Applicant submits that claims 1-3 are directed to statutory subject matter under 35 USC 101.

#### Claim rejections under 35 USC 103

Claim 1 has been rejected under 35 USC 103(a) as being unpatentable over Pennell (2002/0013788) in view of Chennai (article), while claims 2-3 have been rejected under 35 USC 103(a) as being unpatentable over Pennell in view of Chennai, and further in view of Office Notice. Applicant traverses this rejection as to claim 1 as amended, such that claims 2-3, which depend from claim 1, are patentable as well. Applicant provides four reasons why claim 1 as amended is patentable over the cited prior art.

#### *First reason why the claimed invention is non-obvious*

First, claim 1 is directed to a user providing "a plurality" of locations at which the user can receive the order he or she is making. By comparison, Pennell in view of Chennai does not teach

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the user providing a plurality of shipping locations. For instance, in FIG. 4 of Pennell, the user selects a home address, a work address, or another address from the box 405, and then clicks the fill-in button 402 to fill in the shipping information in the box 100 with this selected information. Thus, the order web site of FIG. 4 is provided with a single shipping location. Indeed, the fill-in areas of the box 100 only provide the user with the capability of furnishing a single shipping location.

*Second reason why the claimed invention is non-obvious*

Second, claim 1 is directed to the deliverer “*determining* at time of delivery a current location of the user from the plurality of locations” previously provided by the user, to which the deliverer ultimately delivers the order. Pennell in view of Chennai does not teach the deliverer *determining* a current location of the user to which the deliverer ultimately delivers the order. The Examiner notes that “Pennell . . . does not specifically mention that the shipping address is confirmed before shipment,” but further notes that “Chennai teaches verifying the address of the recipient before delivery.”

However, this is not what the claimed invention is directed to – the invention is not directed to the deliverer “confirming” or “verifying” the address of the recipient before delivery. Rather, claim 1 is limited to the deliverer *determining* a current location of the user. That is, the user provides a number of locations at which he or she may be present. The deliverer thus uses the real-time location access information provided by the user to *determine* which location is the *current* location of the user, to which the deliverer should deliver the order. The deliverer in the claimed invention is not “confirming” or “verifying” the shipping address of the recipient, because the deliverer does not have any indication as to which specific address the order of the recipient should be delivered. Rather, the deliverer is using the real-time location access information to actually *determine* the current location of the user to deliver the order, at the time of delivery, and not simply *confirm* or *verify* the address, as is accomplished by Pennell in view of Chennai.

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*Third reason why the claimed invention is non-obvious*

Third, claim 1 is directed to the deliverer determining *at time of delivery* the current location of the user. By comparison, Chennai in particular notes that the users are notified “through their e-mail or postal address, *prior to delivery*.” Thus, Chennai, and therefore Pennell in view of Chennai, does not disclose the claimed invention, because the claimed invention is limited to the deliverer determining the current location of the user *at time of delivery* – not *prior to delivery*.

*Fourth reason why the claimed invention is non-obvious*

Fourth, Applicant notes that the *determination* of the current location of the user *from a number of locations, at time of delivery* is an important aspect of the invention, and asks that the Examiner carefully consider the following remarks in assessing patentability of the claimed invention. That is, whereas in the previous two described reasons as to why the claimed invention is non-obvious the “determination” limitation and the “at time of delivery” limitation were considered separately, in this fourth reason, these two limitations are taken as a whole. As guided by the MPEP, “the question under 35 USC 103 is not whether the differences *themselves* would have been obvious, but whether the claimed invention *as a whole* would have been obvious.” (*Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983), *cited in* MPEP sec. 2141.02)

Therefore, consider this scenario in the prior art. A user in Pennell in view of Chennai provides his or her home address as the shipping address. Prior to delivery, the deliverer confirms that this is the correct shipping address. However, at the actual time of delivery, the user is not home – and thus cannot take delivery of the item. To this end, Pennell in view of Chennai does not solve the problem noted in the patent application as filed:

Today more people than ever are placing orders for and receiving delivery of items, as opposed to going to a store to purchase and take home the items themselves. . . . However, receiving delivery of their orders is problematic, given the increasingly mobile nature of people. For instance, in the past, there usually

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was one person of a household home at all times, so delivery was simply a matter of delivering an order to the home address of a user, since someone was always likely to be there.

Today, however, frequently no one is home during regular business hours Monday through Friday to accept delivery. Whereas delivery could be made by just leaving the order on a doorstep, this is impractical for expensive items that the person who had placed the order is worried will be stolen. Furthermore, delivery could be made to a neighbor who is at home during the day, but this is inconvenient, especially where the person does not maintain cordial relations with his or her neighbors.

(Paras. [0002]-[0003]) That is, the home address of the user could be confirmed prior to delivery, as in Pennell in view of Chennai, but the user may nevertheless not be home at the time of delivery. Pennell in view of Chennai thus does not render obvious the claimed invention as a whole.

By comparison, claim 1 is directed to a method in which a user makes an order, and provides with that order a number of locations at which he or she can receive the order. *At the time of delivery*, claim 1 is limited to a deliverer *determining* the current location of the user from the number of locations that the user provided, and then delivering the order to the user at this current location. By definition, the user is always at his or her current location, and thus is always there to accept delivery. The invention thus provides the advantages noted in the patent application as filed:

The invention provides for advantages not found within the prior art. The user may, for example, provide a home address, a work address, as well as a second home address as the locations at which the user can accept delivery. The user may also provide the times at which he or she is likely to be at these various locations. . . .

When the deliverer is ready to make delivery, the current location of the user is determined by using the real-time location access information. *Thus, the user who had placed the order does not have to worry about delivery being made when the user is not at home, since the deliverer only attempts delivery to the current location of the user.*

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(Paras. [0005]-[0006]) Pennell in view of Chennai does not provide for these advantages. Only a single address is input, and that address is verified or confirmed *prior to delivery*. However, at the actual time of delivery, the user may not be at the verified or confirmed address, and thus still has to worry about delivery being made when the user is not at this address.

Applicant believes that there may be some confusion as to what the term "current location" of the user means in claim 1. The Examiner is interpreting "current location" of the user to mean where a user actually lives, or actually works. For instance, in Pennell in view of Chennai, the user provides his or her home or work address. However, the "current location" of a user is not necessarily where the user actually lives or works, since the user may be at work, and thus not at home, or may be at home, and thus not at work. The current location of a user is the location where the user currently is – not necessarily where he or she lives or works, and not necessarily the shipping address that he or she input when ordering an item. Thus, Pennell in view of Chennai confirms or verifies the user's shipping address prior to delivery, which is not the user's current location at time of delivery. A shipping address may still be correct, even if the user is not currently there. This is why Pennell in view of Chennai does not render the claimed invention obvious. The claimed invention uniquely determines the user's current location at time of delivery, and delivers the item to that current location. By definition, a user is always at his or her current location. Pennell in view of Chennai verifies the user's shipping address prior to delivery, and delivers the item to that verified shipping address – even if the user is not currently at that address (i.e., that address is not the user's current location).

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Conclusion

Applicants have made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Mike Dryja, Applicants' Attorney, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



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Date

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